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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,206	06/01/1999	WILLIAM R. BANDY	1689.0010001	8893

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/323,206

Applicant(s)  
Bandy et al

Examiner  
James W. Myhre

Art Unit  
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on June 1, 1999; November 19, 1999; and February 15, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 76-108 is/are pending in the application.
- 4a) Of the above, claim(s) 76-91 and 105 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 92-103 and 106-108 is/are allowed.
- 6) ☒ Claim(s) 104 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 1, 1999 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 9
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5 and 7 6) ☐ Other:

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### **DETAILED ACTION**

1. The preliminary amendments of June 1, 1999 (paper no. 4), November 19, 1999 (paper no. 6), and February 15, 2002 (paper no. 8) have been entered and considered by the Examiner. Upon entry of these three amendments, the currently active claims are Claims 76-108.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 76-91, drawn to a manufacturing process for an electronic tag, classified in class 340, subclass 572.1.
  - II. Claims 92-104 and 106-108, drawn to an inventory method with contention resolution, classified in class 705, subclass 28.
  - III. Claim 105, drawn to a surveillance system with an alarm, classified in class 340, subclass 825.36.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inventory method of Group II may use the electronic tag manufactured in Group

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I. However, other electronic tags could also be used to perform the steps of Group II.

Therefore, the two inventions are separately distinct.

4. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the surveillance system in Group III may use the electronic tag manufactured in Group I. However, other electronic tags could also be used to perform the steps of Group III. Therefore the two inventions are separately distinct.

5. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions pertain to different fields of art. Group II conducts an inventory of a plurality of products with attached electronic tags within a specified area and performs contention resolution thereon. Group III conducts a security surveillance of a plurality of items with attached electronic tags within a specified area and initiates an alarm if any of the items are removed from the specified area. Group II does not contain any limitation pertaining to initiating alarms, and Group III does not contain any limitation pertaining to contention resolution during an inventory process. Therefore, the two invention are separately distinct.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Robert Sokohl on May 29, 2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 92-104 and 106-108. Affirmation of this election must be made by applicant in replying to this Office action. Claims 76-91 and 105 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

***Allowable Subject Matter***

9. Claims 92-103, 106-108 contain allowable subject matter.

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***Statement of Reasons for the Indication of Allowable Subject Matter***

10. The following is a statement of reasons for the indication of allowable subject matter:

While prior art was found which disclosed systems and methods using electronic tags to track and locate items such as luggage (Kaplan et al, US 3, 689,885)(Wade, William, Electronic News) and prior art was also found which disclosed procedures for conflict resolution between multiple tags using random time differentiation to respond to a polling signal (Reis et al, EP 0,467,036), prior art was not located in which multiple tags were polled within a specified location to identify the items and which also handled contention between the identity signals from one or more tags within the location by using a secondary identification number stored in each tag. Therefore, the Examiner considers the combination of polling a plurality of electronic tags and resolving contention between the tags by the tags responding with a secondary identification code as the novelty of the invention.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. Claim 104 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Reis et al (EP 0,467,036).

Claim 104: Reis discloses an inventory system comprising a plurality of passive electronic tags and a tag reader (col 1, lines 23-32) which performs multiple reads of the tags to avoid time slot contention (col 7, lines 2-37).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Griffith et al (5,887,176) discloses a system and method for remotely monitoring and tracking a plurality of items using electronic tags (transponders), which respond with their unique identification numbers. However, multiple identification number for each tag is not disclosed.

b. Adamec et al (5,917,422) discloses a system and method for assigning electronic serial numbers (identification numbers) to electronic tags. However, it is not disclosed that a tag will receive multiple identification numbers.

c. Woolley (5,959,568) discloses a system for measuring the distance to a moving object using electronic tags which respond to a prompt signal. It is not disclosed that each tag has multiple identification numbers.

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d. Manjo (5,963,133) discloses an electronic tag which may be programmed with information identifying the item to which it is attached. However, it is not disclosed that a tag has multiple identification numbers,

e. Bowers et al (6,025,780) discloses an electronic security system and method using electronic tags and a reader which detects the tags within a detection zone and electronically deactivates the tags. However, it is not disclosed that a tag has multiple identification numbers.

f. Engellenner (6,057,756 and 6,388,569) discloses a system for locating objects by searching for electronic tags attached to each object. The system uses a plurality of sensing devices or “sweeps” to determine the exact location of each object within the area. However, it is not disclosed that a tag has multiple identification numbers.

g. Guthrie et al (6,058,374) discloses a system and method for monitoring items using electronic tags which transmit identification information at various times to avoid contention. However, it is not disclose that a tag has multiple identification numbers.

h. Mon (6,354,493) discloses a system and method for finding a specific electronic tag among a plurality of such tags by prompting the tags to transmit their identification number to the receiver. However, it is not disclosed that a tag has multiple identification numbers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

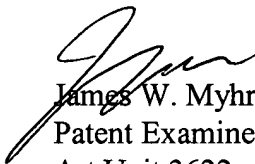


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM  
May 30, 2002

  
James W. Myhre  
Patent Examiner  
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